

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KAREN GOTTLIEB-MYERS  
and  
DALE MICHAEL FETTER LEIGH

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Appeal No. 2004-1282  
Application No. 10/037,668

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ON BRIEF

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Before KIMLIN, OWENS and DELMENDO, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-25, all the claims in the present application. Claim 1 is illustrative:

1. In combination for propelling an element toward an individual holding a member for striking the element,

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a switch carried by the individual and manually actuatable between first and second states of operations,

a transmitter carried by the individual and connected to the switch for transmitting signals upon the manual operation of the switch by the individual between the first and second states of operation,

the switch and the transmitter being disposed on one hand of the individual for providing for a transmission of signals from the transmitter to the propulsion mechanism when the switch is operated between the first and second states, one of the hands of the individual also holding the member for striking the element propelled from the propulsion mechanism when the transmitter sends the signals to the propulsion mechanism,

a propulsion mechanism displaced from the switch and the transmitter and constructed to propel the element upon actuation, and

a receiver disposed in the propulsion mechanism and energizable by the signals from the transmitter for providing an actuation of the propulsion mechanism to obtain the propulsion of the element by the propulsion mechanism.

In the rejection of the appealed claims, the examiner relies upon the following references:

O'Brien	4,722,625	Feb. 2, 1988
Rappaport et al.	6,190,271	
(Rappaport '625)		Feb. 20, 2001
Rappaport et al.	6,371,871	Apr. 16, 2002
(Rappaport '871)		
Brown	6,440,013	Aug. 27, 2002

Appellants' claimed invention is directed to a combination for propelling an element, such as a ball, toward an individual holding a member, such as a bat. The invention comprises an electrical switch disposed on a hand of the individual which

actuates a transmitter which sends signals to a propulsion mechanism, e.g., a batting machine. The transmitter is also disposed on the hand of the individual. In essence, the invention allows for the individual, or batter, to activate the switch which ultimately causes the batting machine to propel the ball toward the batter.

Appealed claims 1, 2, 5-7, 9, 11, 13 and 17-20 stand rejected under 35 U.S.C. § 102(e) as anticipated by either Rappaport '871 or Rappaport '271 or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over the Rappaport references in view of O'Brien. Claims 3, 4, 8, 10, 12, 14-16 and 21 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Rappaport references in view of O'Brien. In addition, claims 1-12 and 17-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Brown in view of O'Brien.<sup>1</sup> Also, claims 13-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of the Rappaport references,

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<sup>1</sup> The statement of the rejection at page 7 of the Answer fails to include the rejection of claims 6-12. However, it is clear from the body of the Examiner's Answer that claims 6-12 are included in the § 103 rejection over Brown in view of O'Brien. Also, since appellants have acquiesced to the examiner's finding that all the appealed claims stand or fall together, appellants are not prejudiced by our interpretation of the examiner's rejection.

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O'Brien and Official Notice, as well as the combination of Brown, O'Brien and Official Notice.

Appellants submit at page 8 of the Brief that the examiner's grouping of the appealed claims "is satisfactory to applicant [sic, applicants]." Since the examiner has determined that all the appealed claims stand or fall together, we will limit our consideration to the examiner's rejections of appealed claim 1.

We have thoroughly reviewed the respective positions advanced by appellants and the examiner. In so doing, we find that the examiner's rejections under § 102 are not well-founded. However, we are in complete agreement with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's § 103 rejections for essentially those reasons expressed in the Answer.

We consider first the examiner's rejection under § 102 over either of the Rappaport patents. The references, like appellants, disclose a system wherein an individual, or batter, activates a switch which transmits a signal to a batting machine-type apparatus which propels a ball toward the individual upon reception of the signal. Unlike the present invention, the

switch and transmitter of the Rappaport references are located on the bat that is held by the individual. Consequently, we agree with appellant that the references do not describe within the meaning of § 102 the claim requirement that the switch and transmitter be disposed on the hand of the individual. We do not subscribe to the examiner's reasoning that "[i]nasmuch structure provided by appellant [sic, appellants] in the claim, when the user holds the bat the switch and transmitter are 'disposed' on one hand of the individual and when the finger engages the switch, the switch is 'disposed' on the finger of the individual" (page 4 of Answer, third full sentence). Rather, it is our view that, when the claim language is given its broadest reasonable interpretation consistent with the specification, the claim requires that the switch and transmitter are disposed on or attached to the individual in some manner.

The examiner's rejections under § 103 are, however, another matter. We fully concur with the examiner that O'Brien evidences the obviousness of modifying the system of Rappaport such that the activating switch and transmitter are disposed on or attached to the hand of the individual. Although O'Brien is directed to a powered painting system and not a batting system, we find that

O'Brien meets the second test of analogous art inasmuch as O'Brien is reasonably pertinent to the problem addressed by Rappaport, Brown and appellants. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). In particular, O'Brien, like appellants, Rappaport and Brown, is concerned with an individual activating the propulsion of a material from a device at a specific time desired by the individual. Also, while appellants maintain that the present invention "pertains to apparatus for pitching baseballs," and that "[t]he O'Brien patent is not applicable as prior art because the O'Brien patent relates to painting apparatus" (page 9 of Brief, second paragraph), the examiner properly responds with the following:

With regards to Appellant's [sic, Appellants'] remarks that O'Brien and Rappaport et al patents are not related, it is noted that the independent claims as rejected over Rappaport et al and O'Brien do not require for the member to be a baseball bat, the element to be a ball or the propulsion mechanism to be a pitching machine used in baseball. As a matter of fact with the exception of claims 19 and 21, the remainder of the pending claims do not require that the invention be used in a baseball environment, nor is there any suggestion in the claims that the member is a bat and the element is a ball. The use of switches to actuate a signal between a transmitter and a receiver is well known and used in combination with many propulsion mechanisms and members. Therefore, there is nothing unobvious about combining references to show that the claimed control assembly is well known and it

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can be and has been positioned directly or indirectly on a member for actuating a signal between the transmitter and receiver [paragraph bridging pages 11 and 12 of Answer].

Appellants also contend that none of Rappaport, Brown and O'Brien discloses or suggests the combination of the claimed features since

Rappaport and Brown do not disclose or suggest the disposition of a switch and a transmitter on a batter's hand and O'Brien does not disclose or suggest an apparatus responsive to signals from a transmitter for propelling an element (e.g. a ball) to a batter for the striking of the element by a member (a bat) held by the batter.

(Page 14 of Brief, first full paragraph). However, appellants' argument is based upon an improper individual attack on the references rather than the requisite collective teachings that one of ordinary skill in the art would have gleaned from the combined references as a whole. In re Keller, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981).

As a final point, with respect to the § 103 rejections, appellants base no argument upon objective evidence of nonobviousness, such as unexpected results.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
	)	
TERRY J. OWENS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
ROMULO H. DELMENDO	)	
Administrative Patent Judge	)	

ECK:clm



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